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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,617	12/14/2001	Mark A. Heldreth	1671-0171	7934

7590 01/04/2005

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EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/017,617	HELDRETH ET AL.	
	Examiner	Art Unit	
	Anu Ramana	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,23-29,31-39 and 41-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-29 and 31-33 is/are allowed.
- 6) ☒ Claim(s) 21,23-25,34-39 and 41-45 is/are rejected.
- 7) ☒ Claim(s) 41, 46 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Objections***

Claim 41 is objected to because of the following informalities. In line 2, "be" should be inserted after "to" and before "driven" to correct a minor typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 23-25, 34-38 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by LaSalle et al. (US 5,976,147).

LaSalle et al. disclose a modular system or "prosthesis evaluation assembly," including a trial tray 12, fixation pins 14 to fix trial tray 12 to a tibia via apertures 32 in trial tray 12, an evaluation member (16,18) having a number of spikes 86, a trial insert 20 with a recess 124 to receive the distal end of post 18 of the evaluation member, a drill bushing or "tool guide" 22 and a drill 24 (Figs. 1-5 and 13, col. 1, lines 6-11, col. 3, lines 63-67, col. 4, lines 1-67, col. 5, lines 1-65 and col. 7, lines 10-42).

The method steps of claims 34-38 are inherently performed when the LaSalle et al. modular system is used during bone preparation and trial reduction phases of joint arthroplasty surgery.

Claims 21, 24, 25, 39, 42-43 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by LaSalle et al. (US 5,976,147).

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LaSalle et al. disclose a modular system or "prosthesis evaluation assembly," including a trial tray 12 with an opening 30, fixation pins 14 to fix trial tray 12 to a tibia via apertures 32 in trial tray 12, a tibial bearing insert or "evaluation member" 20 and a drill bushing or "drill guide" 22 that can be aligned with opening 30 when the evaluation member is positioned away or "not attached" to trial tray 12 (Figs. 1-5 and 13, col. 1, lines 6-11, col. 3, lines 63-67, col. 4, lines 1-67, col. 5, lines 1-65 and col. 7, lines 10-42).

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on October 12, 2004 have been carefully considered.

With regard to claim 21, Applicants' arguments are not persuasive because lower portion 16 of the LaSalle et al. evaluation member has a lip 60 that contacts and rests on ledge 58 of the tray when it is placed in the tray (see Figures 1 and 2).

With regard to claim 34, it is the Examiner's position that the tibia is manipulated or "handled" during placement of trial insert 20 on post 18 of the evaluation member of La Salle et al.

Allowable Subject Matter

Claims 41, 46 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 26-29 and 31-33 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anu Ramana*
December 28, 2004

Cary E. O'Connor
Cary E. O'Connor
Primary Examiner